

### **REMARKS/ARGUMENTS**

Applicant has reviewed and considered the Office Action mailed on November 16, 2006, and the references cited therewith.

No claims were amended, canceled, or added. Claims 1-27 are pending in this application.

Applicant notes that the Examiner has identified claim 1-25 as pending. Applicant submits that this is incorrect. On October 21, 2005 Applicant responded to an Office Action dated August 10, 2005. In that response, Applicant filed new claims 26 and 27. As a result, claims 1-27 are pending and not claims 1-25 as indicated by the Examiner.

In addition, Applicant was not able to find the detailed basis for the rejection of claims 22 and 25 in the November 16, 2006 Office Action. Applicants request the basis for the rejection of claims 22, 25, 26 and 27, if any, in the next official communication.

#### **§103 Rejection of the Claims**

Claims 1, 2, 9, 12, 13, 23 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827) and Moraw et al. (U.S. Pat. No. 4,324,421).

Claims 3 and 5 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of Killey (U.S. Pat. No. 5,342,672).

Claims 4, 6-8, 10, 11, 14-16, and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of McConville et al. (U.S. Pat. No. 4,968,063).

Claims 17 and 18 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw et al. as applied to claims 1, 2, 9, 12, 13, 23 and 24 above and further in view of Killey and McConville et al.

Applicant traverse the rejections as follows.

Claim 1

Applicant submits that cited documents do not support a proper prima facie case of obviousness as the documents, besides other things, do not teach or suggest all the claim elements recited in claim 1. For example, Applicant is unable to find in Stephens, Smith and/or Moraw a teaching or a suggestion of a transparent data sheet that includes, besides other things, a transparent durable layer and a transparent fragile layer, where printed identification and/or verification information is provided on one of the transparent durable layer and the transparent fragile layer, and the two layers are laminated together, as recited in claim 1. In addition, Applicant submits that there is insufficient motivation to combine Stephens Smith and Moraw as asserted by the Examiner.

In the Office Action, the Examiner asserts that:

Stephens discloses a security feature (16), a transparent layer (12) and a transparent layer (12'). . . . Smith discloses . . . indicia on a transparent layer associated with an information bearing assembly (see column 2, lines 10-16). It would have been obvious . . . to provide Stephens with indicia on one of its transparent layers in the manner as taught by Smith in order to provide more information to the user. Stephens as modified by Smith lacks the disclosure of fragile and durable layer. Moraw et al disclose "It can also be advantageous to protect the polyethylene films, which although firm are soft, with harder films. To achieve this, film laminated of polyester films with polyethylene films can be used for the outer covering layers." It would have been obvious to . . . provide the transparent layers of Stephens as modified by Smith with polyester films to achieve a fragile and durable layer in the manner as suggested by Moraw et al. in order to enhance the durability of the assembly.

Applicant traverses these assertions.

As provided by the Examiner, the transparent layer of Stephens is to be provided with the indicia of Smith. The Examiner then asserts that Stephens as modified by Smith lacks the disclosure of a fragile layer and a durable layer. So, the indicia of Smith cannot be on either of the fragile layer or the durable layer. In

contrast, Applicant's claim 1 recites, in part, that the "printed identification and/or verification information is provided on one of the transparent durable layer and the transparent fragile layer, and the two layers are laminated together." The use of Moraw does not ameliorate these shortcomings of Stephens and Smith, as the film laminates of Moraw are to be applied as outer covering layers to the transparent layer of Stephens. As such, the cited documents do not appear to teach or suggest all the elements as recited in claim 1.

In addition, Applicant submits that there is insufficient motivation to combine the documents as asserted by the Examiner. First, Stephens lacks either an explicit or implicit problem to be solved. One skilled in the art reading Stephens would understand that if more information were need to be provided to a user (the asserted motivation to combine the cited documents), then more information could simply be supplied on the "information card 16" of Stephens. In addition, Stephens does not teach or suggest that there is a motivation to print additional information on either of the plies 12' or 12". Finally, as discussed above, one skilled in the art would easily recognize that if additional information were need to be supplied in the "personal information packet 10" provided by Stephens it could be simply supplied on the "information card 16."

Applicant also submits that modification proposed by the Examiner would also both change the principle of operation of and render the "personal information packet 10" of Stephens unsatisfactory for its intended purpose. For example, Stephens provides that "[t]he notice appearing on the outward face of the information card 16 will be readily visible through the transparent envelope 12 to alert authorities to the availability of the personal information within the packet" (col. 3, lines 33-37). Modifying Stephens as suggested would provide printing on the plies 12', 12" of the plastic envelope 12 that would interfere with the "notice" of the "information card 16" being "readily visible through the transparent envelope 12" as provided by Stephens. In other words, printing on the plies would interfere with a person's ability to see the content of the "information card 16." As such, there

would be no suggestion or motivation to make the proposed modification as asserted by the Examiner.

Based on the forgoing, reconsideration and withdrawal of the 103 rejection for independent claim 1, as well as those claims which depend therefrom is respectfully requested.

## Claim 2

Applicant submits that cited documents do not support a proper prima facie case of obviousness as the documents, besides other things, do not teach or suggest all the claim elements recited in claim 2. For example, Applicant is unable to find in Stephens, Smith and/or Moraw a teaching or a suggestion of a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer, where the two layers are laminated together to form a laminate, where the laminate is durable, as recited in claim 2.

As provided by the Examiner, the transparent layer of Stephens is to be provided with the indicia of Smith. The Examiner then asserts that Stephens as modified by Smith lacks the disclosure of a fragile layer and a durable layer. So, the indicia of Smith cannot be on the fragile layers, as recited in claim 2. The use of Moraw does not ameliorate these shortcomings of Stephens and Smith, as the film laminates of Moraw are to be applied as outer covering layers to the transparent layer of Stephens. As such, the cited documents do not appear to teach or suggest all the elements as recited in claim 2.

In addition, Applicant submits that there is insufficient motivation to combine the documents as asserted by the Examiner. Applicant respectfully repeats the arguments presented above for claim 1 in support of this position.

Based on the forgoing, reconsideration and withdrawal of the 103 rejection for independent claim 2, as well as those claims which depend therefrom is respectfully requested.

### Claims 23 and 24

For independent claims 23 and 24, the Examiner has asserted that "Stephens inherently teaches the method in claims 23 and 24 and substantially all of the subject matter set forth in the claims except for the claimed layer materials and indicia on one of its transparent layers. Smith discloses that it is well known in the art to provide indicia on a transparent layer associated in an information bearing assembly (see column 2, lines 10-16)." Applicant respectfully traverses as follows.

Applicant submits that Stephens, Smith and Moraw do not support a proper prima facie case of obviousness as the documents, besides other things, do not teach or suggest all of the elements recited in claims 23 and 24. In addition, Applicant submits that there is insufficient motivation to combine Stephens, Smith and Moraw as asserted by the Examiner.

Applicant submits the cited documents do not teach or suggest, besides other things, a process for manufacturing a transparent data sheet that includes, besides other things, providing a printable surface of a first fragile layer and providing a second layer, which is a durable layer or is a fragile layer, where the combination of the first and second layer provide a durable sheet, as recited in claim 23. As discussed above for claims 1 and 2, Stephens and Smith do not teach or suggest a fragile layer and a durable layer. The Examiner, however, indicates that it would have been obvious to provide the transparent layer of Stephens with the indicia of Smith. As such, printing the indicia of Smith on the transparent layer of Stephens would not be done on either a fragile layer or a durable layer.

The Examiner asserts, however, that the "transparent layers of Stephens as modified by Smith [could be modified] with polyester films to achieve a fragile and durable layer in the manner as suggested by Moraw et al. in order to enhance the durability of the assembly." This proposed modification, however, still does not teach or suggest the subject matter recited in claim 23 as Moraw teaches that the film laminates are to be applied to the outer covering layers (i.e., the transparent layers) of Stephens. As such, the cited documents do not teach or suggest all the elements recited in claim 23.

In addition, Applicant submits the cited documents do not teach or suggest, besides other things, a process of manufacturing a transparent data sheet that includes printing identification information onto a surface of a first layer and laminating the printed surface of the first layer to another layer, where both layers are optically transparent and one layer is more fragile than the other, as recited in claim 24. As discussed above for claims 1 and 2, the Examiner has asserted that the indicia of Smith has been applied to the transparent layer of Stephens, where neither Stephens nor Smith teaching or suggestion of a fragile layer and/or a durable layer. As such, it is not possible for Stephens to inherently teach the method recited in claims 23 and 24

Applicant further submits that there is insufficient motivation to combine the documents as asserted by the Examiner. Applicant respectfully repeats the arguments presented above for claim 1 in support of this position.

In addition, Applicant submits that a proper rejection based on inherency has not been made. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in original). Applicant submits, however, that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. As such, a proper rejection based on inherency has not been made.

Based on the forgoing, Applicant submits that each and every element as recited in independent claims 23 and 24 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

#### Claims 3 and 5

Claims 3 and 5 are rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and Moraw and further in view of Killey (U.S. Pat.

No. 5,342,672). Applicant respectfully traverses the rejection of the claims as follows.

Applicant submits that the modification proposed by the Examiner (where the transparent fragile layer of claims 1 and 2 is either a holographic foil or a foil) would render the "envelope 12" of Stephens unsatisfactory for its intended purpose. The intended purpose of Stephens is to produce a personal information packet having a folded information card sealed within a transparent plastic envelope rugged enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies (e.g., 12' or 12") of the "envelope 12" of Stephens with the holographic hot-stamp foil of Killey would defeat this purpose of the rugged transparent plastic envelope of Stephens as holographic foils and foils are known to be fragile.

Furthermore, Applicant submits that this proposed modification would further change the principle of operation of Stephens. In this situation, Stephens's principle of operation appears to be to provide a rugged transparent plastic envelope containing a folded information card, where the transparent plastic envelope is tough enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies of this envelope with a holographic foil or a foil would change the principle operation as at least one of the plies would no longer be tough enough to withstand such rough treatment. This in turn would lead to the folded information card being either easily accessed or unintentionally separating from the envelope that is intended to protect the card until its use is needed.

Based on the forgoing, reconsideration and withdrawal of the 103 rejection for claims 3 and 5 is respectfully requested. In addition, Applicant submits that claims 3 and 5 are allowable as being dependent claims on allowable independent claims 1 and 2.

#### Claims 4, 6, 15 and 16

Applicant submits that the modification proposed by the Examiner (where the transparent fragile layer of claims 1 and 2 is either a retroreflective layer of glass

beads in a beadbond layer or an optical stack) would render the "envelope 12" of Stephens unsatisfactory for its intended purpose. As discussed above, the intended purpose of Stephens is to produce a personal information packet having a folded information card sealed within a transparent plastic envelope rugged enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies (e.g., 12' or 12") of the "envelope 12" of Stephens with either the retroreflective layer of glass beads in a beadbond layer or an optical stack would defeat this purpose of the rugged transparent plastic envelope of Stephens as such structures are known to be fragile.

Furthermore, Applicant submits that this proposed modification would further change the principle of operation of Stephens. In this situation, Stephens's principle of operation appears to be to provide a rugged transparent plastic envelope containing a folded information card, where the transparent plastic envelope is tough enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies of this envelope with either glass beads in a beadbond layer or an optical stack would change the principle operation as at least one of the plies would no longer be tough enough to withstand such rough treatment. This in turn would lead to the folded information card being either easily accessed or unintentionally separating from the envelope that is intended to protect the card until its use is needed.

Based on the forgoing, reconsideration and withdrawal of the 103 rejection for claims 4, 6, 15 and 16 is respectfully requested. In addition, Applicant submits that claims 4, 6, 15 and 16 are allowable as being dependent claims on allowable independent claims 1 and 2.

#### Claims 17 and 18

Claims 17 and 18 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith as applied to claims 1, 2, 9, 12, 13, 23 and 24 above, and further in view of Killey and McConville et al. Applicant respectfully traverses the rejection of the claims as follows.



Applicant submits that the modification proposed by the Examiner (where the transparent fragile layer of claims 1 and 2 is either a retroreflective layer of glass beads in a beadbond layer and/or a holographic foil) would render the "envelope 12" of Stephens unsatisfactory for its intended purpose. As discussed above, the intended purpose of Stephens is to produce a personal information packet having a folded information card sealed within a transparent plastic envelope rugged enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies (e.g., 12' or 12") of the "envelope 12" of Stephens with either the retroreflective layer of glass beads in a beadbond layer and/or a holographic foil would defeat this purpose of the rugged transparent plastic envelope of Stephens as such structures are known to be fragile.

Furthermore, Applicant submits that this proposed modification would further change the principle of operation of Stephens. In this situation, Stephens's principle of operation appears to be to provide a rugged transparent plastic envelope containing a folded information card, where the transparent plastic envelope is tough enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies of this envelope with either glass beads in a beadbond layer or a holographic foil would change the principle operation as at least one of the plies would no longer be tough enough to withstand such rough treatment. This in turn would lead to the folded information card being either easily accessed or unintentionally separating from the envelope that is intended to protect the card until its use is needed.

Based on the forgoing, reconsideration and withdrawal of the 103 rejection for claims 17 and 18 is respectfully requested. In addition, Applicant submits that claims 17 and 18 are allowable as being dependent claims on allowable independent claims 1 and 2.

#### Claims 22, 25, 26 and 27

Applicant's respectfully note that claims 26 and 27 were presented as new claims in their October 21, 2005 response to the August 10, 2005 Non-Final Office

Action. The Advisory Action and Final Office Action, however, do not indicate that claims 26 and 27 are either pending or rejected. In addition, a basis for any rejection or non-entry of claims 26 and 27 to which the Applicant has had an opportunity to respond has not been made on the record.

Claims 22 and 25 were also indicated to be rejected on the Final Office Action summary sheet, but Applicant was not able to find the detailed basis for the claims rejection in the Final Office Action. As it appears claims 22, 25, 26 and 27 have not been properly rejected, Applicant respectfully requests consideration and allowance of claims 22, 25, 26 and 27.

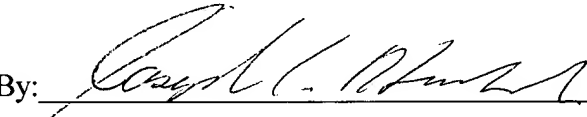
Reconsideration and withdrawal of the § 103 rejection for the rejected claims are respectfully requested.

**CONCLUSION**

Applicant submits that the claims are in condition for allowance and notification to that effect is earnestly requested.

The Examiner is invited to telephone the applicants' below signed attorney or Melissa E. Buss, Esq. at (651) 733-0649 to facilitate prosecution of this application.

Respectfully submitted,

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